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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,060	05/25/2001	James W. Whittaker	HME/8134.003	4178

29085 7590 07/08/2003

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EXAMINER
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PAK, YONG D

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/866,060

Applicant(s)

WHITTAKER ET AL.

Examiner

Yong D Pak

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-8, 10-11 and 16-20.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The amendment filed on June 5, 2003 under 37 CFR 1.116, canceling claims 6-8, 10-11, 16-17 and 19 and adding claims 21-22, in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment raises new issues that would require further consideration and/or search.

Claims 1-8, 10-11 and 16-20 are pending.

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 103***

Applicant's arguments are moot as drawn to rejection of claims 1, 3-8, 10-11 and 16 under 35 U.S.C. 103(a) as being unpatentable over Golightly et al. in view of Zamost et al. since the proposed amendment is not entered. The proposed amendment of claim 1 and newly submitted claims 21-22 raise new issues that would require further consideration. The new issue raised is the two temperature requirements during culturing the transformed yeast cell and induction of the promoter.

Applicant's arguments are moot as drawn to rejection of claims 2 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golightly et al. in view of Zamost et al. as applied to claims 1, 3-8, 10-11 and 16 above, and further in view of Montague-Smith et al. since the proposed amendment is not entered. The proposed amendment of claim 1 and newly submitted claims 21-22 raise new issues that would

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require further consideration. The new issue raised is the two temperature requirements during culturing the transformed yeast cell and induction of the promoter.

***Claim Rejections - 35 USC § 112***

Applicant's arguments are moot as drawn to rejection of 17-20 are rejected under 35 U.S.C. 112, second paragraph since the proposed amendment is not entered. The proposed amendment of claim 1 and newly submitted claims 21-22 raise new issues that would require further consideration. The new issue raised is the two temperature requirements during culturing the transformed yeast cell and induction of the promoter.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong D. Pak  
Patent Examiner

July 1, 2003

  
PONNATHAPU ACHUTAMURTHY  
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